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Appl. No. 09/902,144
Atty. Docket No. 8633
Amdt. dated May 03, 2005
Reply to Office Action of November 3, 2004
Customer No. 27752

rejection there must be no difference between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 USPQ 10, 12 (CCPA 1967); *Scripps v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

As the Office Action expressly recognizes that the *Dulaney et al* reference does not disclose the use scenario data operable to receive hypothetical sets of constant value data (Office Action dated 11/03/2005, Page 8, Lines 11-13), Applicant respectfully asserts that the above referenced claims, as amended, are patentable and respectfully requests that the rejection under 35 USC 102(b) be withdrawn.

Rejection Under 35 USC 103(a) Over *Dulaney et al* (U.S. Pat. No. 6,341,269 B1) in view of *Jameson* (U.S. Pat. No. 6,625,577 B1)

Claims 10 and 11 have been rejected under 35 USC 103(a) as being unpatentable over *Dulaney et al* (U.S. Pat. No. 6,341,269 B1) in view of *Jameson* (U.S. Pat. No. 6,625,577 B1). Applicants respectfully traverse this rejection as there is no motivation to combine the cited references to achieve Applicant's claimed invention. Therefore, Applicants' contend that the claimed invention is unobvious and that the rejection should be withdrawn.

As is fundamental, a *prima facie* case of obviousness must be based on facts, "cold hard facts." *In re Freed*, 165 USPQ 570, 571-72 (C.C.P.A. 1970). When the rejection is not supported by facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (B.P.A.I. 1993).

As is well settled, an Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would *impel* one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993). The rejection fails to provide any reason why one would be motivated, let alone impelled, to combine the *Dulaney et al* and *Jameson* references in the manner suggested by the Examiner. Thus, the rejection fails to set forth the required facts and reasoning required to support a *prima facie* case of obviousness.

A *prima facie* case of obviousness, however, requires that the rejection describe with specificity why one skilled in the art would have combined two references to arrive at the claimed invention. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (CAFC 1999). ("Our case law makes clear

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that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of *the requirement for a showing of the teaching or motivation to combine prior art references.*"). In the present case, no such explanation is found in the rejection.

Thus, the rejection is not supported by the kind of specificity required to sustain a conclusion of obviousness. *Ex parte Humphreys*, 24 USPQ 2d 1255, 1262 (BPAI 1992).

Obviousness, however, cannot be based upon speculation. Nor can obviousness be based upon possibilities or probabilities. Obviousness *must* be based upon facts, "cold hard facts." *In re Freed*, 165 USPQ 570, 571-72 (CCPA 1970). When a conclusion of obviousness is not based upon facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (BPAI 1993).

Moreover, whether or not *Dulaney et al* and *Jameson* are non-analogous arts, it remains that the question of "non-analogous art" is relevant to whether it would be proper to combine references. *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). That is, even when references are in related arts, the Examiner still has the burden of establishing (1) that there is a suggestion or motivation to combine the references relied upon, and (2) that the references, when so combined, contain the requisite suggestion and motivation which would have led one to combine the particular disclosure relied upon and to make the invention as claimed. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The Examiner was required to demonstrate *where* in *Dulaney et al* and *Jameson* there is a suggestion which would have "strongly motivated" one to make product factor optimization systems as claimed. *Ex parte Graselli*, 231 USPQ 393, 394 (Bd. App. 1986). The type of motivation which would have "impelled" one to do so (*Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993)), and the type of suggestion that the changes "*should*" be made. *Ex parte Markowitz*, 143 USPQ 303, 305 (Bd. App. 1964).

Because the Examiner has not identified *any* suggestion, reason, or other motivation, including suggestion of desirability, for *why* one would have combined the *Dulaney et al* and *Jameson* references, the rejection should be withdrawn. Accordingly, Applicant respectfully asserts that for these reasons the rejection of the above referenced claims under 35 USC 103(a) is in error and should be withdrawn.

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Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the objection to Claim 22, and the rejections under 35 USC 101, 35 USC 102(e), 35 USC 103(a), and 35 USC 112, Second Paragraph. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 3-8, 11-19 and 21-24.

Respectfully submitted,

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